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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,385	10/26/2001	William E. Taylor	01-328	4949

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EXAMINER

FISCHETTI, JOSEPH A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,385

Applicant(s)

TAYLOR, WILLIAM E.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02062006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-23,48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-23,48,49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al. in view of Manzi and Longfield.

Hoyt et al. disclose a method for automatically determining taxes for a contract for equipment, including the steps of establishing a set of contract characteristics (provided by central registry 306); establishing customer location information (inherent to the data inputted into the contract formation system). However, Hoyt et al. do not disclose automatically determining an appropriate set of tax rules to apply as a function of the customer location information; determining a contract type based on the contract characteristics under the set of tax rules; and, calculating a tax amount based on the contract characteristics, the contract type, and the set of tax rules.

Manzi does disclose determining an appropriate set of tax rules to apply as a function of the customer location information (col.3); determining a contract type based on the contract characteristics under the set of tax rules (col. 4 lines 20-38); and, calculating a tax amount based on the contract characteristics, the contract type, and the set of tax rules (Tax is paid ,see abstract 2nd to last sentence).

It would be obvious to modify the method in Hoyt et al to include a lease based scheme as taught by Manzi in the automatic contract former of Hoyt et al the motivation for which is found in the streamlining of processes. It is noted that Hoyt et al. disclose in col. 33 a Quick Close contract which includes "negotiated terms that meet certain

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business parameters” leading to the suggestion of the fully automated process of contract radification including an understanding of the tax effects of the contract. Thus, there is clear motivation to take what is alleged to be done manually in Manzi and implement it automatically as part of the certain business parameters of Hoyt et al. Official Notice is taken regarding the recited factors of location, contract characteristics and contract type as impacting on the contract tax effects, see e.g. *West's Advanced Taxation*.

However, the above combination appear silent regarding the feature of selecting a paying party from a group of paying parties to pay the tax amount as a function of the set of tax rules. However, Longfield discloses plural paying parties, namely an authorized preparer or an authorized financial institution 100 see col. 3 lines 41 et seq. and, depending upon a given set of rules which are established in advanced, selecting one to be the payor. It would be obvious to modify the aforesaid combination to include the teaching of Longfield to provide a selection between parties would are to pay on another's behalf based on predetermined rules, the motivation being that the person most responsible for the paying should be the one who should pay.

Manzi also answers as follows:

Re claims 2, 3, a contract is a lease.

Re claims 4,5, 6 and 7,12 tax authority would inherently include all taxing jurisdictions common to a given area. The tax base is a function of law not invention.

Re claims 8,9 the lessor is the paying party.

Re claims 10-13, 16 official notice is taken of the known use of installment paying, the use of invoices and zip codes.

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Re claim 14. a product family and a model number for the equipment disclosed in col. 3 line 40.

Re claim 15 see col.4 lines 50 et seq.

Re claim 17: the system inherently records a residual amount due at end of contract.

Re claims 18-20 each equipment piece is given a book value which translates to a purchase price/option.

Re claim 21 inherent to any transaction is a mandatory final payment.

Re claim 22. An obvious expedient to the leasing of a vehicle is the trade option.

Re claim 48: Official notice is taken to power/size taxation rates. See, *West's Advanced Taxation* and mil rates for car taxes.

Re claim 49 Longfield discloses the selecting of a payor e.g. a from among a group including a financing company- e.g. bank/credit card issuer, or a tax preparer.

The motivation for combining Manzi to include these features in Hoyt et al. and Loingfield remains as stated above the motivation for which is found in the streamlining of processes.

Applicant's arguments filed 2/06/06 have been fully considered but they are not persuasive. Applicant argues that the prior art does not show selecting a paying party from a group of paying parties to pay the tax amount as a function of the set of tax rules. However, the examiner in the office action has been clear to point to Manzi col. 4 lines 20-38 that there are rules which are applied to determine if taxes on the equipment

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rented, are to be paid by one of a group of paying parties, namely the customer, or the lessor or its agent. The rules tell the system what the tax is based on the selection of the device paid thus there is a rule driven selection process. See col. 4 line 44. Longfield discloses the selecting of a payor e.g. a from among a group including a financing company- e.g. bank/credit card issuer, or a tax preparer or the IRS based upon tax rules (see, IRS Pub 1345 lists authorized RAL filers who are also payors). Thus, Longfield provides a teaching for selecting payors based upon a set of tax rules, the tax rules setting forth the requirements allowing a preparer to be considered authorized or not. Thus, Long field is responsive to the tax rules aspect of the claim language and Manzi is responsive to the commercial aspect of the selection process e.g., customer location (state), contract characteristics (equipment type). The motivation to combine is clear given that almost every commercial transaction has both private and governmental components to it.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

 **JOSEPH A. FISCHETTI**
PRIMARY EXAMINER

Joseph A. Fischetti
Primary Examiner
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